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09/760,226	01/12/2001	Michael D. Levison	CVC 100	1727

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/760,226

Applicant(s)

LEVISON, MICHAEL D.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/27/2001.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1-24 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8, and 17-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of providing incentives or rewards for insurance policies. The recited steps constitute an idea on how to target incentives to customers who purchase insurance.

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Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for targeting rewards to users who purchase insurance.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-5, 8, 17-23 are deemed to be directed to non statutory subject matter. The Examiner suggests that Applicant include a recitation within the body of the independent claims (not just the preamble) that at least some of the steps are carried out by the use of technology (i.e. computer, server).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-13, and 16-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray, Christian M., "Web discounts are on the way" (hereinafter Murray).

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As to claims 1-8, Murray discloses A method of targeting an incentive reward to an individual conducting an activity of interest, wherein the incentive reward is an insurance coverage credit that can be used to purchase an insurance policy or pay premiums on an increment of insurance coverage (15 percent cash rebate on their first year premiums if they buy through Wholesale's Web site)(page 1).

As to claims 9-13, and 17 Murray discloses An insurance system comprising: an item selected from the group consisting of: (1) a credit to purchase insurance or pay premiums on insurance; and (2) insurance wherein the item is awarded by a first entity, and the insurance is for a second entity, wherein the insurance is against the occurrence of a potential hazard having causative factors; wherein the first entity awards the item to the second entity in order to induce the second entity to take some action, wherein the action taken has no substantial bearing on reducing the likelihood of occurrence of the causative factors; and wherein the second entity may or may not have existing insurance(15 percent cash rebate on their first year premiums if they buy through Wholesale's Web site)(page 1).

As to claim 16, 18-24, Murray discloses An insurance system comprising awarding of an item selected from the group consisting of (1) a credit to purchase an insurance policy; and (2) an insurance policy, wherein the award is made by a first entity to a second entity for reasons selected from the group consisting of: marketing promotions; encouraging the second entity to use an Internet site; purchase of a product by the second entity; lease of a tangible or intangible product by the second entity; use

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of a service by the second entity (15 percent cash rebate on their first year premiums if they buy through Wholesale's Web site)(page 1).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claim 15 is rejected under 35 U.S.C. 102(a) as being anticipated by Webb et al, "Banks in Asia Beef up Retail Business – Bad brush with corporate Clients Spurs Shift to Consumers after Crisis" (hereinafter Webb), .

As to claim 15, Webb discloses An insurance system comprising awarding of an item to an entity for free, wherein the item is selected from the group consisting of (1) a credit to purchase insurance or pay premiums on insurance; and (2) insurance page 2, last paragraph and page 3, first paragraph).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray as applied to claim 9 above, and further in view of Webb.

As to claim 14, Murray does not explicitly disclose The system of claim 9, wherein the insurance policy is awarded without charge to the second entity.

However, Webb discloses providing insurance coverage free of charge to customers (i.e. free accidental death insurance coverage)(page 2, last paragraph and page 3, first paragraph). It would have been obvious tone of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Webb within Murray for the motivation of enticing new customers (page 2, last paragraph and page 3, first paragraph)

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 6,347,302 discloses a method of providing lease insurance and incentives.

b. "East PASCO AARP offers driving course discloses a method of offering discounts on auto insurance.

c. "Something Borrowed, Something Blue" and your Insurance Needs Review the internet helps Newlyweds Save money on Insurance" discloses discounts provided to households that insure more than one car.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is stylized with a large, sweeping initial 'A' and a long, horizontal stroke extending to the right.

Alexander Kalinowski

Primary Examiner

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5/15/2004